



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,019	10/15/2003	John Barrus	20412-07973	9125

758 7590 03/30/2006

FENWICK & WEST LLP  
SILICON VALLEY CENTER  
801 CALIFORNIA STREET  
MOUNTAIN VIEW, CA 94041

EXAMINER

BOTTS, MICHAEL K

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,019

Applicant(s)

BARRUS ET AL.

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/15/03; 10/7/04; 6/13/05; 3/3/05; etc.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5 IDS filings</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on October 15, 2003, which claims priority as a continuation in part from the following applications:
  - a. U.S. Application 10,404,916, which was filed on March 31, 2003;
  - b. U.S. Application 10,404,927, which was filed on March 31, 2003;
  - c. U.S. Application 10,639,282, which was filed on August 11, 2003;and,
  - d. U.S. Application 10,665,097, which was filed on September 16, 2003.
2. Claims 1-67 have been examined, with claims 1, 4, 18, 33, 56, 57, 59, 62, 63, and 64 being the independent claims.
3. The Drawings are objected to.
4. Claims 30, 33, and 41 are objected to.
5. Claims 1-67 are rejected.

### ***Information Disclosure Statement***

6. Signed and dated copies of applicant's IDS form 1449's, which were filed on the following dates, are attached to this Office Action: October 7, 2004; June 13, 2005; March 3, 2005; November 3, 2005; and, March 3, 2006.

Art Unit: 2176

7. The following deficiencies and comments are noted regarding the

Applicants IDS filings:

- a. IDS filed January 13, 2005: Non-Patent Literature Document cite C76 is not found in the USPTO records and appears to have been omitted from the filing.
- b. IDS filed October 7, 2004: Foreign Patent Documents EP 737 927 A2; EP 459 174 A2; and , EP 378 848 A2 are not found in the USPTO records and appear to have been omitted from the filing.
- c. IDS filed November 3, 2005: Non-Patent Literature Document cite C2 has been reviewed by the Examiner, but is not to be entered in the list of citations should a patent issue, and is therefore marked through by the Examiner.
- d. In general, it is noted that duplicate documents appear in the filings, which unduly burdens the record and the examination of this application.

### ***Drawings***

The drawings are objected to because of the following:

- a. The Figures must be numbered consistently and consecutively.

For example, the first figure is labeled "1B," but there is no "1A;"

- b. Figures 1B, 5A, 5B, and 12 include photographs or reproduced pictures that are of poor quality such that it is difficult or impossible to understand the drawings; and,

Art Unit: 2176

c. Figure 12 includes identifications numbers located on shaded portions of the Figure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***The Specification***

8. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claims Objections***

10. Claims 30, 33, and 41 are objected to because of the following informalities:

**Regarding claim 30**, line 2, it is believed that applicants intended to include a semi-colon after the word "comprises."

**Regarding claim 33**, line 5, it is believed applicants intended to include the word "and" after ";

**Regarding claim 41**, line 8, it is believed that applicants did not intend to end with the word "and."

### ***Claims Rejections – 35 U.S.C. 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2176

11. **Claims 1 and 2** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-2 are drawn to a computer implemented process that merely manipulates data or an abstract idea without limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application, it must produce a "useful, concrete and tangible result." *State Street Bank & Trust Co., v. Signature Financial Group*, 149 F.3d 1368,1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). See also, MPEP 2106, II. A.

Claims 1 and 2 merely manipulate data by receiving documents in an order, wherein it is noted that more than one document received is inherently ordered by the order of receipt, and performing an unspecified action on the group of document. There is no useful, concrete, tangible result from these claims.

12. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

### ***Claims Rejections – 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2176

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1-7, 11, 12, 16, and 17** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dozier, et al. (U.S. Patent 5,870,552, issued February 9, 1999) [hereinafter "Dozier"].

Regarding **independent claim 1**, Dozier teaches:

*A method of composing a collection of information comprising:  
receiving a plurality of documents in an order; and  
performing at least one action on a stored document collection,  
wherein  
the at least one action is selected responsive to the order of  
the documents.*

(See, Dozier, Figure 7, and col. 3, line 41 through col. 4, line 43, teaching the input and storage and manipulation of electronic documents and that the documents may be ordered.)

Regarding **dependent claim 2**, Dozier teaches:

*The method of claim 1, wherein the at least one action is selected  
from a group of actions.*

(See, Dozier, Figure 7, and col. 4, lines 11-26, teaching that the document collections may be re-ordered and modified.)



Regarding **dependent claim 3**, Dozier teaches:

*The method of claim 2, wherein the group of actions comprises at least one selected from the group consisting of:*

*creating a new collection; and*

*adding a document to a collection.*

(See, Dozier, col. 4, lines 11-18, teaching that the new collections may be created or old collections added to.)

Regarding **independent claim 4**, Dozier teaches:

*A method of composing a collection of information comprising:*

*receiving a first document;*

*receiving at least one subsequent document;*

*determining whether the first document includes an indicium*

*identifying a collection;*

*responsive to the determination, selecting among the actions of:*

*adding the at least one subsequent document to the*

*collection identified by the indicium; and*

*creating a new collection; and*

*performing the selected action.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new

Art Unit: 2176

collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.)

Regarding **dependent claim 5**, Dozier teaches:

*The method of claim 4, wherein the action of creating a new collection further comprises adding the at least one subsequent document to the new collection.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.)

Regarding **dependent claim 6**, Dozier teaches:

*The method of claim 4, wherein selecting the action comprises: responsive to the first document including an indicium identifying a collection, selecting the action of adding the at least one subsequent document to the collection identified by the indicium.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the documents to an existing or new collection.)

Regarding **dependent claim 7**, Dozier teaches:

*The method of claim 4, wherein selecting the action comprises:*

*responsive to the first document not including an indicium*

*identifying a collection, selecting the action of creating a new collection.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, and generating a new collection by associating the documents together, with the selected action being a new collection.)

Regarding **dependent claim 11**, Dozier teaches:

*The method of claim 4, further comprising:*

*responsive to the first document including an indicium identifying a*

*first collection, and a subsequent document including an indicium*

*identifying a second collection, adding at least a subset of the contents of*

*the second collection to the first collection.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.)

Regarding **dependent claim 12**, Dozier teaches:

*The method of claim 4, further comprising:*

*responsive to the first document including an indicium identifying a first collection, and a subsequent document including an indicium identifying a second collection, adding the second collection as a subcollection of the first collection.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.)

Regarding **dependent claim 16**, Dozier teaches:

*The method of claim 4, wherein each collection comprises at least one multimedia item.*

(See, Dozier, Figure 7, teaching the inclusion of a "gif" file, a multimedia file typically a graphic, in a document collection along with "htm," "stl," "nvm," and text documents. See also, Dozier, col. 3, line 41 through col. 4, line 43, teaching receiving a first and subsequent document, determining an indicia identifying a collection being the determination of hyperlinks linking the document, and generating a new collection by associating the documents together, with the selected action being the addition of the all or part of the documents to an existing or new collection.

It is noted that the application does not define the term "multimedia."

Accordingly, it will read as was known to a person of ordinary skill in the art at the

Art Unit: 2176

time of the invention, as defined in "Microsoft Computer Dictionary," Fifth Edition, 2002, Microsoft Press, as follows: "The combination of sound, graphics, animation, and video. In the world of computers, multimedia is a subset of hypermedia, which combines the aforementioned elements with hypertext."

There is no limitation in Dozier to the number of times a multimedia item may be included in a collection, and, upon teaching that a multimedia item may be included in one collection, without further limitation, it is inherent that a multimedia item may be included in all collections.)

Regarding **dependent claim 17**, Dozier teaches:

*The method of claim 4, wherein each collection comprises at least one item selected from the group consisting of:*

*documents;*

*images;*

*files;*

*video data; and*

*audio data.*

(See, Dozier, col. 4, lines 6-10, teaching the linking of hypermedia. See also, Dozier, col. 3, line 41 through col. 4, line 43, teaching collections of documents.)

14. **Claims 18-22 and 24-27** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chen, et al., (U.S. Patent 6,009,442, issued December 28, 1999) [hereinafter "Chen"].

Art Unit: 2176

Regarding **independent claim 18**, Chen teaches:

*A method for adding an annotation to a collection of information,  
comprising:*

*receiving an annotated media item identifying the collection of  
information;*

*reading the annotation from the media item; and*

*adding the annotation to the collection of information.*

(See, Chen, col. 3, line 37 through col. 4, line 61, teaching a document collection.

See also, Chen, col. 18, lines 42-55, teaching an annotations utility that receives annotated media, reads the annotation and adds annotations to the collection of documents.)

Regarding **dependent claim 19**, Chen teaches:

*The method of claim 18, wherein adding the annotation comprises:*

*retrieving, from a storage device, the identified collection;*

*modifying the retrieved collection to add the annotation; and*

*storing the modified collection.*

(See, Chen, col. 5, line 51 through col. 6, line 12, teaching storage of the documents and collections. See also, Chen, col. 3, line 37 through col. 4, line 61, teaching a document collection. See also, Chen, col. 18, lines 42-55, teaching an annotations utility that receives annotated media, reads the annotation and adds annotations to the collection of documents.)

Regarding **dependent claim 20**, Chen teaches:

Art Unit: 2176

*The method of claim 18, wherein the collection of information comprises a collection of multimedia documents.*

(See, Chen, col. 4, lines 12-19, teaching that documents of various types may be stored, including multimedia documents, e.g., JPEG.)

Regarding **dependent claim 21**, Chen teaches:

*The method of claim 18, wherein receiving the annotated media item comprises scanning the item.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner.)

Regarding **dependent claim 22**, Chen teaches:

*The method of claim 18, wherein receiving the annotated media item comprises receiving an e-mail message including the item.*

(See, Chen, col. 3, lines 47-59, teaching the receipt of documents via e-mail.)

Regarding **dependent claim 24**, Chen teaches:

*The method of claim 18, wherein the annotation is handwritten.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. It is inherent in scanning that any handwritten annotation will be scanned in with the rest of the document.)

Regarding **dependent claim 25**, Chen teaches:

*The method of claim 18, wherein receiving an annotated media item comprises receiving a paper document.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner.)

Regarding **dependent claim 26**, Chen teaches:

*The method of claim 18, wherein receiving an annotated media item comprises receiving a collection coversheet.*

(See, Chen, col. 18, line 56 through col. 19, line 44, teaching a coversheet associated with documents and document collections.)

Regarding **dependent claim 27**, Chen teaches:

*The method of claim 18, wherein the annotated media item further comprises a pointer to the collection.*

(See, Chen, col. 1, line 64 through col. 2, line 42, teaching that summaries of documents are kept in a separate but associated file. See also, Chen, col. 5, line 52 through col. 9, line 53, teaching the use of pointers to associated files, including collections.)

15. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be



Art Unit: 2176

considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

***Claims Rejection – 35 U.S.C. 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 8-10, 13-15**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier, et al. (U.S. Patent 5,870,552, issued February 9, 1999) [hereinafter "Dozier"].

Regarding **dependent claim 8**, Dozier teaches:

*The method of claim 4, further comprising:*

*for at least one of the subsequent documents, receiving a separator prior to receiving the document.*

(Dozier teaches the association of a series of documents in a sequential order.

Dozier does not expressly teach a "separator."

A separator is disclosed by the Applicants as follows: "A separator page 2601, an example of which is shown in FIG. 7, can be used to denote the end of

Art Unit: 2176

*one document 104 and the beginning of a new document 104. MFP 100 detects separator page 2601 and, thereby recognizes that a new document 104 is about to begin. Separator page 2601 makes it possible for the user to queue several documents for MFP 100 to scan in one stack. In one embodiment, separator page 2601 is an easily produced sheet of paper with a printed machine-readable indicator such as a barcode 2602. Separator page 2601 may be similarly formatted as a collection coversheet. Alternatively, separator page 2601 may be any kind of separator identifiable by MFP 100."* Disclosure, paragraph [0093].

The "separator" of the instant application is merely a document in Dozier, which may be placed between other documents according to the teachings of Dozier. The function of the document is the same whether it is called a "separator" or whether it is named anything else.

The differences between Dozier and a "separator" is only found in the nonfunctional descriptive material and does not alter how the invention functions. Thus, the descriptive material will not distinguish the claimed invention for the prior art in terms of patentability. See, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to place a document between to other documents because the name of the document is non-functional and any document will perform the same function.)

Regarding **dependent claim 9**, Dozier teaches:

*The method of claim 4, wherein the separator comprises a piece of paper including a separator indicium.*

(Dozier teaches the association of a series of documents in a sequential order.

Dozier does not expressly teach a “separator comprising a piece of paper including a separator indicium.”

A separator is disclosed by the Applicants as follows: “A separator page 2601, an example of which is shown in FIG. 7, can be used to denote the end of one document 104 and the beginning of a new document 104. MFP 100 detects separator page 2601 and, thereby recognizes that a new document 104 is about to begin. Separator page 2601 makes it possible for the user to queue several documents for MFP 100 to scan in one stack. In one embodiment, separator page 2601 is an easily produced sheet of paper with a printed machine-readable indicator such as a barcode 2602. Separator page 2601 may be similarly formatted as a collection coversheet. Alternatively, separator page 2601 may be any kind of separator identifiable by MFP 100.” Disclosure, paragraph [0093].

The “separator” of the instant claim is a piece of paper which is entered into the computer system as a document and is merely a document in Dozier, which may be placed between other documents according to the teachings of Dozier. The function of the document is the same whether it originates as a piece of paper before being entered into the computer and is called a “separator”

Art Unit: 2176

or whether it enters the computer in any other manner and is named anything else.

The differences between Dozier and a "separator" is only found in the nonfunctional descriptive material and does not alter how the invention functions. Thus, the descriptive material will not distinguish the claimed invention for the prior art in terms of patentability. See, *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to place a piece of paper as a separate document between to other documents and to enter them as separate documents into the computer because the origin and name of the document is non-functional and any document will perform the same function.)

Regarding **dependent claim 10**, Dozier teaches:

*The method of claim 4, wherein each document comprises at least one piece of paper, and wherein receiving the document comprises scanning the at least one piece of paper.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim 4. Dozier does not expressly teach that each document comprises at least one piece of paper, and wherein receiving the document comprises scanning the at least one piece of paper.

Art Unit: 2176

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including scanning a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to scan a document into the computer for purposes of saving time over re-typing the document or for purposes of inputting graphics or other data.)

Regarding **dependent claim 13**, Dozier teaches:

*The method of claim 4, wherein:*

*receiving a first document comprises scanning a piece of paper;*

*and*

*receiving at least one subsequent document comprises scanning at*

*least one piece of paper.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim 4. Dozier does not expressly teach that receiving a first document comprises scanning a piece of paper and receiving at least one subsequent document comprises scanning at least one piece of paper.

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including scanning a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to scan a document into the computer for

Art Unit: 2176

purposes of saving time over re-typing the document or for purposes of inputting graphics or other data.)

Regarding **dependent claim 14**, Dozier teaches:

*The method of claim 4, wherein:*

*receiving a first document comprises receiving the document by fax transmission; and*

*receiving at least one subsequent document comprises receiving the at least one document by fax transmission.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim

4. Dozier does not expressly teach that receiving a first document comprises receiving the document by fax transmission and receiving at least one subsequent document comprises receiving at least one document by fax transmission.

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including faxing a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to fax a document into the computer for purposes of rapid and accurate inputting of graphics or other data.)

Regarding **dependent claim 15**, Dozier teaches:

*The method of claim 4, wherein:*

Art Unit: 2176

*receiving a first document comprises receiving the document by e-mail transmission; and*

*receiving at least one subsequent document comprises receiving the at least one document by e-mail transmission.*

(See, Dozier, col. 3, line 41 through col. 4, line 43, teaching the invention of claim

4. Dozier does not expressly teach that receiving a first document comprises receiving the document by e-mail transmission and receiving at least one subsequent document comprises receiving at least one document by e-mail transmission.

The Examiner takes official notice of the fact that method steps that are performed by computer include the manipulation of data that is inputted to the computer by well known prior art means including e-mailing a document into a computer memory. It would have been obvious to a person of ordinary skill in the art at the time of the invention to e-mail a document into the computer for purposes of rapid and accurate inputting of graphics or other data.)

17. **Claims 23 and 28-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, et al., (U.S. Patent 6,009,442, issued December 28, 1999) [hereinafter "Chen"]..

Regarding **dependent claim 23**, Chen teaches:

*The method of claim 18, wherein receiving the annotated media item comprises receiving a fax transmission including the item.*

Art Unit: 2176

(See, Chen, col. 3, lines 47-59 and col. 9, lines 55-61, teaching that documents may be received from various sources, including from a local area network [LAN], or from the internet. Chen does not expressly teach the receipt of documents through fax transmission.

The Examiner takes official notice of the fact that method steps of receiving documents into a computer from "various sources," including a LAN and the internet, includes receipt of documents through well known prior art means including via fax transmission. It would have been obvious to a person of ordinary skill in the art at the time of the invention to input documents to a computer using fax transmission for purposes of rapid and accurate inputting of graphics or other data.)

Regarding **dependent claim 28**, Chen teaches:

*The method of claim 18, wherein reading the annotation from the media item comprises scanning an annotation region of the media item.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach scanning only the region of the media item with an annotation.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to limit the range of the scan at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could comprise a scan of a mere portion of the



Art Unit: 2176

document for purposes of efficiency in scanning time and memory usage as well as to focus the material scanned into the computer to a smaller region such as a graphic, a picture, or a portion of a text as compared to the whole of a document.)

Regarding **dependent claim 29**, Chen teaches:

*The method of claim 18, wherein reading the annotation from the media item comprises performing optical character recognition on at least a portion of the media item.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach performing optical character recognition on at least a portion of the media item.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to perform an optical character recognition (OCR) function at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could include OCR conversion of text for purposes of efficiency and speed in entering text data.)

Regarding **dependent claim 30**, Chen teaches:

*The method of claim 18, wherein reading the annotation from the media item comprises*

Art Unit: 2176

*scanning at least a portion of the media item to obtain an image;*

*and*

*removing preprinted marks from the image.*

(See, Chen, col. 9, line 54 through col. 11, line 23, teaching importation of document using a scanner. Chen does not expressly teach removing preprinted marks from an image.

The Examiner takes official notice of the fact that method steps of scanning a document into a file were at the time of the invention well known to included the ability to edit or otherwise modify the image of the scan at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that a scan of a document could include editing and document modification features of a scanned document for purposes of cleaning up, cropping, or artfully modifying a document, etc.)

Regarding **dependent claim 31**, Chen teaches:

*The method of claim 30, wherein the preprinted marks comprise lines.*

(Claim 31 incorporates substantially similar subject matter as claimed in claim 30, and is rejected along the same rationale.)

Regarding **dependent claim 32**, Chen teaches:

*The method of claim 18, wherein reading the annotation from the media item comprises:*

Art Unit: 2176

*retrieving a previously stored media item; and*  
*extracting differences between the previously stored media item*  
*with the received annotated media item.*

(Chen teaches the invention of claim 18. Chen does not teach comparing a new document with a stored document.

The Examiner takes official notice of the fact that method steps of adding a document into a file were at the time of the invention well known to included the ability to compare two documents at the discretion of the user. It was well known by a person of ordinary skill in the art at the time of the invention that any two documents may be compared to each other for purposes of reflecting edits, discovering differences, identification of documents, etc.)

18. **Claims 33-67** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier, et al. (U.S. Patent 5,870,552, issued February 9, 1999) [hereinafter "Dozier"] as applied to claims 1-7, 11, 12, 16, and 17 above, in view of MacPhail, (U.S. Patent 5,280,609, issued January 18, 1994) [hereinafter "MacPhail"] and further in view of Bergen, (U.S. Patent 5,710,874, issued January 20, 2998) [hereinafter "Bergen"].

Regarding **independent claim 33**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A method of providing differentiated access to a collection of*  
*information, the method comprising:*

Art Unit: 2176

*generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;*

*outputting a representation of the first pointer.*

(It is noted that the application discloses a "pointer" as follows: *"Each collection has a specific, unique address or identifier, such as a uniform resource locator (URL), which provides a pointer to the collection. References herein to a pointer, collection identifier, or distributed resource identifier (DRI) can be considered to refer to a URL or any other mechanism, tag, handle, pointer, or technique for identifying a file, collection, directory, or other group of files."* See, disclosure, paragraph [0053].

Dozier teaches a method of providing differentiated access to a collection of information, but does not expressly teach a pointer to a collection of information specifying a first access level from a plurality of access levels.

MacPhail teaches a pointer, or "LADN entry," to a security level associated with a document for the purpose of restricting access and users of the document. See, MacPhail, col. 4, lines 4-65, teaching the pointer and security levels.

Dozier and MacPhail are combinable because they both involve access to documents scanned or otherwise incorporated into an electronic form, with Dozier teaching multiple documents in files and security associated with access to those files, and with MacPhail teaching multiple page documents in files and a specific method of security involving a pointer.

Art Unit: 2176

The suggestion to combine the references may be found in Dozier, col. 15, lines 8-21, stating, in relevant part: "for example, a service might involve . . . specified access controls (such a security restrictions and access costs . . . ." Dozier also teaches access based on the first page of a collection with links to other pages, in a similar manner to that taught by MacPhail. See, Dozier, col. 8, lines 52-66. MacPhail teaches security of access to the files in a more specific teaching.

It would have been obvious to one of ordinary skill in the art to have combined the teachings of multiple document files with security with the teachings of MacPhail to use pointers to identify the security limitations because MacPhail teaches a specific means to implement document security on the same types of scanned electronic documents as those taught in Dozier.

The combination of Dozier and MacPhail teaches a method of providing differentiated access to a collection of information, and teaches a pointer to a collection of information specifying a first access level from a plurality of access levels, but does not expressly teach printing out a representation of the pointer.

Berger teaches a system for managing printing system memory that includes a security code printed out on a machine readable sheet, with such code limited to certain users with permission to access the printer. See, Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system.

Bergen is combinable with Dozier and MacPhail because they all involve access to documents scanned or otherwise incorporated into an electronic form, with Dozier teaching multiple documents in files and security associated with

Art Unit: 2176

access to those files, with MacPhail teaching multiple page documents in files and a specific method of security involving a pointer, and with Bergen teaching a security system with a pointer to the documents that may be printed out.

The suggestion to combine the references may be found in Dozier, col. 15, lines 8-21, stating, in relevant part: “for example, a service might involve . . . specified access controls (such a security restrictions and access costs . . . .” Dozier also teaches access based on the first page of a collection with links to other pages, in a similar manner to that taught by MacPhail. See, Dozier, col. 8, lines 52-66. MacPhail teaches security of access to the files in a more specific teaching. Bergen adds to the teaching of MacPhail by teaching to print out the security access printer for use by authorized individuals.

It would have been obvious to one of ordinary skill in the art to have combined the teachings of Dozier and MacPhail to use pointers to restrict security in accessing multiple document files with the teachings of Bergen that the security pointer is printed out as a means of accessing the documents because Dozier and MacPhail teach the internal security system while Bergen teaches a means of user interaction with that system.)

Regarding **dependent claim 34**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the first pointer identifies a directory containing the collection, the directory further containing a file indicating the first access level.*

Art Unit: 2176

(The rejection of claim 33 is incorporated by this reference. In addition, MacPhail teaches that each document is assigned a unique name and a LADN. A LADN is defined in MacPhail as a pointer. See, MacPhail, col. 4, lines 4-42.)

Regarding **dependent claim 35**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the first pointer specifies the first access level by identifying a file indicating the access level.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching access by security levels. It would have been obvious to one of ordinary skill in the art to have combined the print out of the security authorization with the appropriate designation of a security level.

The suggestion or motivation to indicate an access level is taught in MacPhail, col. 4, lines 4-16, teaching access by security levels, and is taught in Bergen, col. 11, lines 14-19, teaching that the print out of the pointer is for the purpose of limiting users to only those with authorization.)

Regarding **dependent claim 36**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising generating a machine-readable indicium representing the first pointer, wherein outputting the representation of the first pointer comprises outputting a document including the machine-readable indicium.*

Art Unit: 2176

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document including the machine-readable indicium as a "machine readable code.")

Regarding **dependent claim 37**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 36, wherein outputting the document comprises printing a paper coversheet.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code.")

Regarding **dependent claim 38**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 37, wherein the paper coversheet comprises a collection overview, and wherein the first pointer specifies a first access level for a first region within the collection overview, and wherein the first pointer further specifies a second access level for a second region within the collection overview.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and



Art Unit: 2176

the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code.)

Regarding **dependent claim 39**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 36, wherein the indicium comprises a machine-readable code.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document including the machine-readable indicium as a "machine readable code.")

Regarding **dependent claim 40**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar

Art Unit: 2176

code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 41**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising:*

*generating a first machine-readable indicium representing the first pointer, wherein outputting the representation of the first pointer comprises outputting a first document including the first machine-readable indicium;*

*generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level; and*

*generating a second machine-readable indicium representing the second pointer; and*

*outputting a second document including the second machine-readable indicium.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security

Art Unit: 2176

code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 42**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 41, wherein outputting the first document comprises printing a first paper coversheet and outputting the second document comprises printing a second paper coversheet.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 43**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 42, wherein outputting the first document further comprises printing, on the first paper coversheet, a collection identifier that uniquely identifies the collection, and wherein outputting the second document further comprises printing, on the second paper coversheet, the same collection identifier.*

(The rejection of claim 33 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 44**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the plurality of access levels comprises at least one access level selected from the group consisting of:*

*administrator;*

*edit;*

*delete;*

*read-only; and*

*add-only.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching access by security levels. It would have been obvious to one of ordinary skill in the art to have combined the print out of the security authorization with the appropriate designation of a security level.

The suggestion or motivation to indicate an access level is taught in MacPhail, col. 4, lines 4-16, teaching access by security levels, and is taught in Bergen, col. 11, lines 14-19, teaching that the print out of the pointer is for the purpose of limiting users to only those with authorization.

The Examiner takes official notice of the fact that at the time of the invention method steps that limit access to computer files by users or user groups commonly divide the groups into access rights defined as one or more of "administrator; edit; delete; read-only; and add-only," because that set or rights, including reasonable combinations of such rights, defines the set of common and well known actions which may be effected upon an electronic document.

It would have been obvious to one of ordinary skill in the art at the time of the invention to define access rights as comprising one, more, or a combination of the following: "administrator; edit; delete; read-only; and add-only," for purposes of fully describing the extent of routine electronic data manipulation.

Further, it is noted that levels of access to an electronic document which are described as: "administrator; edit; delete; read-only; and add-only," are implicit in a reference that describes limits to security access to an electronic document. "[I]n considering the disclosure of a reference, it is proper to take into

Art Unit: 2176

account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). See also, MPEP 2144.01.)

Regarding **dependent claim 45**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the plurality of access levels comprises at least one access level specifying that access permissions should be inherited from a containing collection.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 7-8, teaching that a security level may be associated with a document as it is filed.)

Regarding **dependent claim 46**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the plurality of access levels comprises at least one access level specifying that access permissions should be applied to documents within a containing collection.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching "clipped" documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a "paper-clip.")

Art Unit: 2176

Regarding **dependent claim 47**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the collection comprises a plurality of documents.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.”)

Regarding **dependent claim 48**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the collection comprises at least one multimedia item.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.” See also, Chen, col. 4, lines 6-19, teaching the storage of a variety of file types, including multimedia items, e.g.: “JPEG.”)

Regarding **dependent claim 49**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the collection comprises at least one item selected from the group consisting of:*

*documents;*

*images;*

*files;*

*video data; and*

*audio data.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Chen, col. 4, lines 42-61, teaching “clipped” documents that are collections of documents with separate pointers that are treated as though associated with each other as in joined with a “paper-clip.” See also, Chen, col. 4, lines 6-19, teaching the storage of a variety of file types, including multimedia items, e.g.: “JPEG” which is commonly uses to store an image.)

Regarding **dependent claim 50**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising:*

*receiving the representation of the first pointer;*

*reading the representation; and*

*providing access to the collection, according to the first access level.*

(Claim 50 incorporates substantially similar subject matter as claimed in claim 35, and is rejected along the same rationale.)



Regarding **dependent claim 51**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising:*

*receiving the representation of the first pointer;*

*reading the representation;*

*receiving a signal indicating a request for access to the collection;*

*and*

*responsive to the requested access conforming with the first access*

*level, providing the requested access.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, teaching retrieval of the document.)

Regarding **dependent claim 52**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising:*

*receiving the representation of the first pointer;*

*reading the representation;*

*receiving a signal indicating a request for access to the collection;*

*and*

*responsive to the requested access not conforming with the first*

*access level, denying the request for access.*

Art Unit: 2176

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request.)

Regarding **dependent claim 53**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, wherein the representation further indicates at least one criterion for changing the access level.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request, and that such denial process includes a prompt for a valid security code.)

Regarding **dependent claim 54**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 53, wherein the criterion for changing the access level comprises an expiry criterion.*

(The rejection of claim 33 is incorporated by this reference. In addition, see, Bergen, col. 10, lines 21-29, teaching denial of a security request, and that when the opportunities for entering the code have been exhausted, the program exits.)

Regarding **dependent claim 55**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 33, further comprising outputting a collection identifier that uniquely identifies the collection.*

Art Unit: 2176

(The rejection of claim 33 is incorporated by this reference. In addition, see, MacPhail, col. 4, lines 4-16, teaching that the documents are each assigned a unique identifier. See also, Bergen, Figure 11, teaching that the target document code is printed out, which in the combination of the inventions of MacPhail and Bergen, would be the unique identifier.)

Regarding **independent claim 56**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A method of providing differentiated access to a collection of information, the method comprising:*

*receiving a first document comprising a first machine-readable indicium representing a first pointer to a collection of information, the first pointer specifying a first access level for accessing the collection;*

*generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level;*

*generating a second machine-readable indicium representing the second pointer; and*

*outputting a second document including the second machine-readable indicium.*

(Claim 56 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Art Unit: 2176

Regarding **independent claim 57**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A method of providing differentiated access to a collection of information, the method comprising:*

- receiving a selection of a first access level for a first recipient from a plurality of access levels;*
- receiving a selection of a second access level for a second recipient from a plurality of access levels;*
- generating a first machine-readable indicium pointing to a collection of information, the first indicium further indicating the first access level;*
- generating a second machine-readable indicium pointing to the same collection of information, the second indicium further indicating the second access level;*
- outputting a first document including the generated first machine-readable indicium; and*
- outputting a second document including the generated second machine-readable indicium.*

(Claim 57 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **dependent claim 58**, Dozier in view of MacPhail and further in view of Bergen teaches:

Art Unit: 2176

*The method of claim 57, wherein each machine-readable indicium corresponds to a collection identifier.*

(Claim 58 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **independent claim 59**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A method of providing differentiated access to a collection of information, the collection comprising a plurality of items, the method comprising:*

*receiving a selection of a first access level for a first subset of items in the collection;*

*receiving a selection of a second access level for a second subset of items in the collection;*

*generating a machine-readable indicium pointing to the collection, the indicium further indicating the first access level for the first subset of items and the second access level for the second subset of items; and*

*outputting a document including the generated machine-readable indicium.*

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security

Art Unit: 2176

system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code.)

Regarding **dependent claim 60**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 59, further comprising generating a collection overview representing the collection, wherein the first access level is associated with a first region within the collection overview, and wherein the second access level is associated with a second region within the collection overview.*

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code.)

Regarding **dependent claim 61**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The method of claim 60, wherein each of the regions within the collection overview contains at least one item.*

(Claim 59 incorporates substantially similar subject matter as claimed in claim 41 and, in further view of the following, is rejected along the same rationale. It is noted that a collection is, by definition, comprised of a plurality of items. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Note that Bergen, Figure 11, step 208, tests for the existence of a target document, without which no pointer is assigned to be printed out.)

Regarding **independent claim 62**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A computer program product for providing differentiated access to a collection of information, the computer program product comprising:*

*a computer-readable medium; and*

*computer program code, encoded on the medium, for:*

*generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels;*

*outputting a representation of the first pointer.*

Art Unit: 2176

(Claim 62 incorporates substantially similar subject matter as claimed in claim 33 and is rejected along the same rationale.)

Regarding **independent claim 63**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A system for providing differentiated access to a collection of information, the computer program product comprising:*  
*a first pointer to a collection of information, the first pointer specifying a first access level from a plurality of access levels; and*  
*an output device, for outputting a representation of the first pointer.*

(Claim 63 incorporates substantially similar subject matter as claimed in claim 33 and is rejected along the same rationale.)

Regarding **independent claim 64**, Dozier in view of MacPhail and further in view of Bergen teaches:

*A file for specifying access levels, comprising:*  
*at least two resource identifier paths; and*  
*for each of the resource identifier paths, an indication of access rights;*  
*wherein the access rights for a first resource identifier path differ from the access rights for a second resource identifier path pointing to the same resource.*



Art Unit: 2176

(Claim 64 incorporates substantially similar subject matter as claimed in claim 41 and is rejected along the same rationale.)

Regarding **dependent claim 65**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The file of claim 64, further comprising, for at least one of the resource identifier paths:*

*an indication of a geographic region within a collection representation; and*

*an indication of access rights for items within the geographic region.*

(It is noted that the specification does not discuss the limitation of a “geographic region” and the term will be treated in this Office Action consistent with its ordinary and accepted definition to one of ordinary skill at the time of the invention, which is an area of the earth.

The rejection of claim 41 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a “machine readable code.” See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere

Art Unit: 2176

repeating of the step at different levels is not patentably distinct from generating the access code at one level.)

Regarding **dependent claim 66**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The file of claim 64, wherein at least one of the resource identifier paths identifies a collection.*

(The rejection of claim 41 is incorporated by this reference. In addition, see Bergen, col. 9, line 17 through col. 11, line 19, teaching the security system and the print out of the document sheet including the machine-readable indicium as a "machine readable code." See also, Bergen Figure 11, teaching that the bar code representation of the address/target value is also printed with the security code. Repeating the step of generating the access code at a different level is inherent in the ability to generate the access code at any level, and the mere repeating of the step at different levels is not patentably distinct from generating the access code at one level.

It is noted that the path is the pointer or identifier taught in the prior art and it is inherent that indicating and accessing a collection of documents, as is taught, contains a path within the identifier or pointer identifying the collection by its file name or other file access code.)

Regarding **dependent claim 67**, Dozier in view of MacPhail and further in view of Bergen teaches:

*The file of claim 64, further comprising, for at least one of the resource identifier paths, and indication that access rights should be inherited from a containing collection.*

(Claim 67 incorporates substantially similar subject matter as claimed in claim 64 and, in further consideration of the following, is rejected along the same rationale. See also, Chen, col. 1, lines 44-61, teaching that security authorization may be set at the document containing collection level.)

19. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

### **Conclusion**

20. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Herz, et al. (U.S. Patent 5,754,939), teaching customized electronic identification of documents.

Lopresti, et al. (U.S. Patent 5,754,308), teaching scanning and access to documents using a copier.

Hamilton, (U.S. Patent 5,715,381), teaching a method of creating and managing packages, including multiple documents, in a printing system.

Art Unit: 2176

Cooper, et al. (U.S. Patent 5,680,223), teaching storage, manipulation, and retrieval of scanned files using file labels.

Anderson, et al. (U.S. Patent 5,581,682), teaching annotation and security of electronic documents.

Cotte, et al. (U.S. Patent 5,499,108), teaching document input into a computer system using a scanner or fax.

Klotz, (U.S. Patent 5,459,307), teaching machine readable paper flag for electronic data storage.

Lech, et al. (U.S. Patent 5,369,508), teaching scanner input of hard copy documents to a computer.

Wang, et al. (U.S. Patent 5,299,123), security in accessing an electronic document on a network.

Wang, (U.S. Patent 5,255,389), document replacement and editing on a network with a copier.

Levine, et al. (U.S. Patent 5,060,135), teaching file collections

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is

Art Unit: 2176

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized, sweeping flourish at the end.

**DOUG HUTTON  
PRIMARY EXAMINER  
TECH CENTER 2100**